

REMARKS

Claims 1-33 are pending in this application. After claim amendments, cancellations and withdrawals herein, claims 1-26 will remain under consideration in this application, with claims 28-32 being withdrawn from consideration until their rejoinder.

In the Office Action dated November 10, 2005, the Examiner indicated that claims 1-33 comprise five patentably distinct inventions, and patentably distinct compounds (or species) within each invention. According to the Examiner, the distinct inventions and the distinct compounds within each invention are too numerous to list individually, and the Examiner has required that the application be restricted, under 35 U.S.C. § 121, to one of the following:

- I. Claims 1-26, in part, drawn to compounds/compositions of formula (I), wherein the variable D represents a carboxyl group, and said carboxyl group is selected from the group consisting of diclofenac, ibuprofen, naproxen and 6-methoxy-2-naphthylacetic acid thereof; the variable R1, X and Z are as defined in claim 1; the variable R2 represents a phospholipids head group selected from choline, ethanolamine, inositol and serine thereof, classified in class 558 with various subclasses;
- II. Claims 1-26, in part, drawn to compounds/compositions of formula I, wherein the variable D represents ketorolac, fendosal, tenoxicam or piroxicam thereof; the variables R1, X and Z are as defined in claim 1; the variable R2 represents a phospholipids head group selected from choline, ethanolamine, inositol and serine thereof, classified in class 548/544 with various subclasses;
- III. Claims 1-26, in part, drawn to compounds/compositions of formula I, containing compounds of formula I not encompassed in Groups I-II, classified in class 540/544/546 with various subclasses;
- IV. Claims 27-29, drawn to methods of use (i.e., treating inflammation), classified in class 514 with various subclasses; and
- V. Claims 30-33, drawn to processes of making compounds of formula I, classified in class 558/548/544 with various subclasses.

In addition to the restriction requirement, the Examiner has also required election of a single compound or species for the group chosen. Moreover, the Examiner further requires an election of a single compound including an exact definition of each substitution on the base molecule, i.e., the formula I, wherein a single member at each substituent group or moiety is selected.

In response, Applicants elect Group I, consisting of claims 1-26, as defined by the Examiner. With regard to the further requirement to elect a single compound or species by exactly defining each substitution of the molecule of the general formula I, In order to be responsive to the Examiner's demand to select a single substituent for each position of the molecule of formula I, Applicants elect the following:

R1 is a saturated or unsaturated hydrocarbon chain having from 2 to 30 carbon atoms;

R2 is a phospholipid head group;

D is ibuprofen;

Z is a saturated or unsaturated hydrocarbon chain having from 2 to 15 carbon atoms; and

X is an amino group.

Accordingly, Applicants have amended claims 1 and 11 and have canceled claims 8 and 18 to complete the restriction of invention and election of species. In addition, Applicants have withdrawn claims 28-32 but have amended these claims (and have canceled claim 33) in order to retain the right to rejoinder of these claims. Applicants note that the inventorship for the elected Group I remains unchanged.

However, Applicants contend that parts of the Examiner's requirement are over-restrictive. Applicants contend that, at least in the case of some of these substituents, they should be included in a single group, and Applicants traverse the Examiner's narrow restriction, as discussed below.

For example, compounds having phospholipid head groups such as choline, ethanolamine, inositol and serine are all presumed to function similarly in terms of their cleavability by phospholipases resulting in activation of the conjugated NSAID residue. In

addition, Applicants contend that a distinction among the phospholipid head groups is unnecessary, as it would not require an unduly complicated search to cover all these possibilities. Accordingly, Applicants have elected a species wherein R2 is a phospholipid head group (as currently defined in claim 1), rather than specifying that R2 is selected from the group consisting of choline, ethanolamine, inositol and serine. Yet, should the Examiner insist that further election of species is necessary, Applicants would reluctantly agree to limit R2 by specifying that it is selected from the group consisting of choline, ethanolamine, inositol and serine (and would amend claims 1 and 11, and cancel claims 9 and 19, accordingly).

In addition, Applicants traverse the Examiner's division into different groups of invention by virtue of the hydrocarbon being saturated or unsaturated (as in the definitions of R1 and Z). Applicants contend that such a distinction is unnecessary, as it would not require an unduly complicated search by the Examiner to cover all these possibilities. Accordingly, Applicants have elected R1 as a saturated or unsaturated hydrocarbon chain having from 2 to 30 carbon atoms, but should the Examiner insist that further election of species is necessary, Applicants would reluctantly agree to limit R1 by specifying that it is a saturated hydrocarbon chain having from 2 to 30 carbon atoms. Similarly, Applicants have elected Z as a saturated or unsaturated hydrocarbon chain having from 2 to 15 carbon atoms, but should the Examiner insist that further election of species is necessary, Applicants would reluctantly agree to limit Z by specifying that it is a saturated hydrocarbon chain having from 2 to 15 carbon atoms

Also, the Examiner stated that claim 27, drawn to the use of compounds of formula (I), does not set forth any steps in the method of use and is therefore indefinite, even though the Examiner treated claim 27 as a method of use for prosecution of the restriction requirement. In response, Applicants have canceled claim 27.

Finally, the Examiner indicated that rejoinder of product claims with process claims that are commensurate in scope with the allowed product claims will be permitted once the product claims are found allowable. However, the process claims must be amended to maintain dependency upon the product claims or to otherwise include the limitations of the product claims. Accordingly, Applicants have herein amended the language of the withdrawn non-

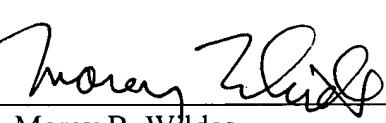
elected claims (e.g., process claims 28-32, with claims 27 and 33 having been canceled) in order to retain the right to rejoinder.

Reconsideration of the present application, as amended, is respectfully requested. If the Examiner has any questions or concerns regarding this response and amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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